



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant : Stephen C. Ekker et al.      Art Unit : 1635  
Serial No. : 09 918,242      Examiner : J. Angell  
Filed : July 30, 2001  
Title : INHIBITION OF GENE EXPRESSION USING POLYNUCLEOTIDE  
ANALOGUES

Commissioner for Patents  
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the Restriction Requirement mailed September 30, 2002, Applicants elect the invention of Group II, claims 21-23 and 59-64. Applicants respectfully traverse this Restriction.

The Examiner stated that the inventions of Groups I and II are related as process of making and product made. The Examiner further stated that the product as claimed can be made by another and materially different process, and used, as an example, a process of mutating the embryo genome such that expression of a nucleic acid is reduced. Applicants respectfully disagree with the Examiner's statements. Mutagenesis would not produce the product as claimed in the claims assigned to Group I, since those claims (e.g., claim 1) recite a "teleost embryo comprising a polynucleotide analogue." A teleost embryo containing a "polynucleotide analogue" cannot be produced using mutagenesis. Therefore, Applicants submit that the product recited in the claims assigned to Group I cannot be made by another and materially different process from that recited in the claims assigned to Group II. Should the claims of Group I be rejoined with the elected claims of Group II, Applicants elect the species of vasculature tissue. Accordingly, Applicants submit that the claims of Group I (claims 1-20 and 40-53) should be rejoined with the claims of Group II (claims 21-23 and 59-64).

## CERTIFICATE OF MAILING BY FIRST CLASS MAIL

Thereby certify under 37 CFR §1.55(a) that this correspondence is being deposited with the United States Postal Service as first class mail with postage paid at the date indicated below and is addressed to the Commissioner of Patents, Washington, D.C. 20231.

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The Examiner stated that the inventions of Groups II and IV are unrelated, because the different inventions are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. Applicants respectfully disagree with the Examiner's statements. Applicants submit that the claims of Groups II and IV are, in fact, related. The claims of Group II are directed toward a "method for producing a teleost embryo" (claim 1), as shown in the following examples, in which a cell having a nucleus is present in an amount effective

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embryo..... comprising...detecting an altered phenotype in said teleost embryo or egg...wherein said altered phenotype is associated with reduced expression...of said selected nucleic acid." Therefore, Applicants submit that the claims of Group II and the claims of Group IV are related because, for example, the two methods are capable of being used together. By way of example, the method of claim 21 could further comprise the step of detecting an altered phenotype (claim 32). Accordingly, Applicants submit that the claims of Group II (claims 21-23 and 59-64) should be rejoined with the claims of Group IV (claims 32-36).

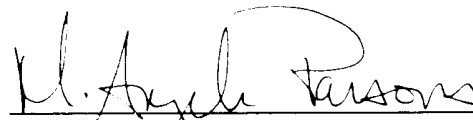
In addition, Applicants note that claims 56-58 are not assigned to a Group. Claims 56-58 depend from claim 55, and therefore should be assigned to Group VII. Applicants respectfully request clarification in the event a future Divisional application is filed that corresponds to the claims of Group VII.

Enclosed is a \$200 check for a Two-Month Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date:

December 4, 2002



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